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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,155	12/10/2001	Frank A. Todaro	2106	7775
28152	7590	07/08/2004		
CHARLES G. NESSLER P.O. BOX H CHESTER, CT 06412			EXAMINER OSELE, MARK A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/016,155	<b>Applicant(s)</b> TODARO ET AL.	
	<b>Examiner</b> Mark A Osele	<b>Art Unit</b> 1734	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.  
     4a) Of the above claim(s) 1-20 and 26-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-22, 25 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                               |                                                                                        |
|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04112002</u> . | 6) <input type="checkbox"/> Other: ____                                                |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 33-35, drawn to a method of splicing sheets including particular sequential motions of a tape guiding foot, classified in class 156, subclass 157.
  - II. Claim 32, drawn to an apparatus for splicing sheets including the slitter carrier assembly capable of moving in coordination with the dispenser-cutter carrier assembly in sequential motions "as shown in Fig. 9", classified in class 156, subclass 353.
  - III. Claims 28-31, drawn to an apparatus for splicing sheets including both first means for releasably frictionally clamping the individual sheets in position on a surface for being spliced together and an array of pins for engaging edge perforations of the sheets, classified in class 156, subclass 505.
  - IV. Claim 27, drawn to an apparatus for splicing sheets including a base, a top movable relative to the base, a slitter carrier assembly, a dispenser-cutter carrier assembly, the top having a means for guiding the two assemblies along the top, and a main body supported upon and interconnecting the assemblies for moving the assemblies along the top, classified in class 156, subclass 506.\*\*\*

- V. Claims 14-20 and 26, drawn to an apparatus for splicing sheets including means for holding two sheets in a fixed position along a butt line; a dispenser-cutter carrier assembly comprising a first body, a tape dispenser movably mounted on the first body, and a cutter carrier assembly movably mounted on the first body; and guide means for guiding the dispenser-cutter carrier assembly along a travel path corresponding with the butt line, classified in class 156, subclass 506.
- VI. Claims 21-25, drawn to an apparatus for splicing sheets including clamp means for holding a pair of sheets in overlapping fashion on the surface of a base; a slitter for transversely slitting the pair of overlapping sheets to create a linear butt line therebetween; taping means for applying tape to the sheets along the butt line; and guide means for guiding both the slitter and the taping means along a linear path corresponding with the butt line, classified in class 156, subclass 505.
- VII. Claims 1-13, drawn to an apparatus for splicing sheets including a base having an x-axis, a top movable relative to the base having an x-axis co-aligning with the base when the top is moved toward the base, a tape dispenser carrier assembly, a slitter carrier assembly for selectively slitting sheets and forming a butt line between overlapping ends of the sheets, and means for guiding the tape dispenser carrier assembly and the slitter carrier assembly along the x-axis of the top, classified in class 156, subclass 505.

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The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-VII are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used for splicing only one pair of sheets together.

3. Inventions II and III-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III-VII have separate utility such as an apparatus for splicing sheets without the slitter carrier assembly capable of moving in coordination with the dispenser-cutter carrier assembly in sequential motions "as shown in Fig. 9". See MPEP § 806.05(d).

4. Inventions III and IV-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions IV-VII have separate utility such as a splicing apparatus without both the means for releasably frictionally clamping the sheets and the array of pins for engaging edge perforations. See MPEP § 806.05(d).

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5. Inventions IV and V-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions V-VII have separate utility such as a splicing apparatus without the combination of the base, the top having means for guiding the carrier assemblies along the top, and the main body supported upon and interconnecting the carrier assemblies for moving the assemblies along the top. See MPEP § 806.05(d).

6. Inventions V and VI-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions VI-VII have separate utility such as a splicing apparatus without the combination of the means for holding sheets in a fixed position along a butt line, the dispenser-cutter carrier assembly comprising a first body, a tape dispenser movably mounted on the first body, and a cutter carrier assembly movably mounted on the first body, and the guide means for guiding the dispenser-cutter carrier assembly along a travel path corresponding with the butt line. See MPEP § 806.05(d).

7. Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as a splicing apparatus without the particular combination of clamp means

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for holding a pair of sheets in overlapping fashion on the surface of a base, slitter for transversely slitting the pair of overlapping sheets to create a linear butt line therebetween, taping means for applying tape to the sheets along the butt line, and guide means for guiding both the slitter and the taping means along a linear path corresponding with the butt line. See MPEP § 806.05(d).

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. With respect to Groups III, VI, and VII, because these inventions are distinct for the reasons given above and the search required for Group III (for example 156/545) is not required for Groups VI and VII, the search for Group VI (156/527) is not required for Groups III or VII, and the search required for Group VII (156/530) is not required for Groups III and VI, restriction for examination purposes as indicated is proper.

10. With respect to Groups IV, and V, because these inventions are distinct for the reasons given above and the search required for Group IV (for example 156/517) is not required for Group V, and the search required for Group V (156/576) is not required for Groups IV, restriction for examination purposes as indicated is proper.

11. During a telephone conversation between Adrienne Johnstone and Charles Nessler on June 17, 2004 a provisional election was made with traverse to prosecute the invention of Group VI, claims 21-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20 and 26-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Pursell et al. Pursell et al. shows an apparatus for splicing sheets comprising: clamp means for holding a pair of sheets in overlapping fashion on a base; a slit for moving one



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direction along guide means to cut through the overlapped sheets; and a taping means moving in the opposite direction along the guide means to apply tape to the cut edges thereby splicing them (column 1, line 45 to column 2, line 11).

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pursell et al. in view of either Nagoshi et al. or Eisenberg. Pursell et al. fails to show the clamping means to be pivotable and having resilient strips thereon.

Nagoshi et al. and Eisenberg each show pivoting clamping means for holding sheets on a base for butt splicing wherein resilient strips on the bottom of the clamping means provide friction to prevent the sheets from slipping (Nagoshi et al., 23; Eisenberg, 33, 34).

### ***Allowable Subject Matter***

17. Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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18. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggest frictional means on the base holding the sheets on the base. The primary reference to Pursell et al. uses vacuum, not friction to hold the sheets on the base. Nagoshi et al. shows sheet conveyors, 24, on the base which may provide friction between the sheets and the base, but there is no indication that the friction between the sheets and the conveyors would be less than the friction between the sheets and the resilient members on the pivoting clamping means.

#### ***Oath/Declaration***

19. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: it is not signed by all of the inventors.

#### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Otomine et al., Hanke, Philippi, Jorgensen, and Hyca each show pivoting clamping members for holding sheets during butt splicing. Rumpel and Rothrock each show guides above the butting sheets for applying the splicing tape.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on Mon-Fri 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MARK A. OSELE**  
**PRIMARY EXAMINER**

June 26, 2004